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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,347	09/23/2003	Hironori Okado	116714	3398
25944	7590	06/03/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			VY, HUNG T	
			ART UNIT	PAPER NUMBER
			2821	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2 ✓

Office Action Summary

Application No.

10/667,347

Applicant(s)

OKADO, HIRONORI

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The first office action sent on 11/17/2004 neglected to treat the preliminary amendment filed on 04.01/2004. The previous of the office action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bancroft et al., U.S. patent No. 6,603,429.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (see table below) of copending Application No. 10/667,347, No. 10/657,108, and No. 10/654432.

10/655,304
1,3 and 15

10/667,347
1,10

10/654,432
1,11

10/657,108
1,11 and 12

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in present application are similar to claims in co-pending application as shown.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the word "saturated" renders the claim indefinite because it is unclear because the claim fail to clearly define saturated. It is not clear how a distance between said planar element and said ground pattern is gradually increased to become saturated. Base on the rejection 112, the application has been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

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except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

Claims 1-18 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Bancroft et al., U.S. patent No. 6,603,429.

Claims 1 and 10, Bancroft et al. disclose an antenna, comprising: ground pattern (50); and a planar element (18), which has a feed point (16) and is juxtaposed with said ground pattern (50), and wherein as being farther away from a straight line passing through said feed position (16), a distance between said planer element (18) and said ground pattern (50) is gradually increased to become saturated (See fig. 1), a dielectric layer 20.

Claim 2, Bancroft et al. disclose a side edge portion of said planar element 18 is constituted by either one of a curved line and line segments, which are connected while their inclination are changed stepwise and said planar element 18 is formed on or in inside a dielectric substrate 20 (See fig. 1).

Claims 3 and 11, Bancroft et al. disclose dielectric substrate further comprising a resonant element 52 connected to an end point of said planar element 18 on said straight line passing through said feed position 16 of said planar element (See fig. 1C).

Claims 4-5, and 12-13, Bancroft et al. disclose resonant element 52 is asymmetrical with respect to said straight line passing through said feed position of said planar element.

Claims 6-7, and 14-15, Bancroft et al. disclose planar element and said resonant element 52 is formed in a same layer of said dielectric substrate 20 (See fig. 1c).

Claims 8-9, and 16-17, Bancroft et al. disclose an antenna, wherein when said planar element 18 and said resonant element 52 are projected on a virtual plane parallel to layers in which the respective elements are formed, said resonant element is disposed without overlapping with a predetermined region defined beside said planar element projected on said virtual plane (See fig. 1 D).

Claim 18, Bancroft et al. disclose a planar element 18 that is fed at a feed position 16; a ground pattern 50 that is juxtaposed with said planar element 18; and second element 52 that is connected with said planar element 18 (See fig. 1).

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 19 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Bancroft et al., U.S. patent No. 6,603,429 in view of admitted prior art (admission) in fig. 16C.

Claim 19, Bancroft et al. disclose all limitation of invention except for different location on second element is connected on planar element. However, Admission disclose on fig. 16 C that second element 1014 a is connected with a first edge part of planar element 1014, said first edge part being opposite to a second edge part of planar element, said second edge part being adjacent to said ground pattern 1011. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Bancroft et al. to have different location of second element as taught by Admission. The motivation for doing so would have been to provide different location of second element on planar element in order to have desire the resonant frequency. Furthermore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have different location of second element, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Conclusion

7. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Vy whose telephone number is (571) 272-1954. The examiner can normally be reached on Monday-Friday 8:30 am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-7722 for After Final communications.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either private Pair or Public Pair. Status information for unpublished applications is available through Private Pair only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy
Art Unit 2821
May 23, 2005.



WILSON LEE
PRIMARY EXAMINER